

Remarks

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendment, claims 63, 65, 66 and 68 are pending in the application, with claim 63 being the sole independent claim. Claim 63 is sought to be amended without prejudice to or disclaimer of the deleted subject matter therein. Claims 64, 67, 69 and 70 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Enablement Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 63, 64, 67, 69 and 70 were rejected under 35 U.S.C. § 112, first paragraph for lack of enablement. Office Action, pages 2-7. Specifically, the Examiner states that the specification:

. . . does not reasonably provide enablement for an agent for treating pain, comprising a conjugate of a galactose-binding lectin, a L-chain or a L-chain fragment of a clostridial neurotoxin comprising the proteolytic enzyme domain, and a translocation domain of a clostridial neurotoxin H-chain, wherein the lectin is obtained from *Bandeirea simplicifolia*, or the lectin has been contacted with an enzyme, or has an amino acid insertion, deletion, or substitution, and retains an ability to bind an oligosaccharide structure having an exposed galactose or N-acetylgalactosamine residue.

Id. at page 3, lines 5-11.

Applicants respectfully traverse the rejection. However, solely to expedite prosecution and not in acquiescence to the rejection, Applicants have removed those claims or portions of claims which are alleged by the Examiner to lack enablement. Accordingly, it is believed that the enablement rejection under 35 U.S.C. §112, first paragraph has been rendered moot. Hence, it is respectfully requested that this rejection be withdrawn and that the claims be allowed.

Written Description Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 63, 64, 67, 69 and 70 were also rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office Action, page 7, lines 9-12. In particular, the Examiner states that "the specification does not describe an agent containing a galactose-binding lectin from *Bandeirea simplicifolia*, a galactose-binding lectin treated with an enzyme or a modified galactose-binding lectin and still retaining the ability to bind an oligosaccharide structure having an exposed galactose or N-acetylgalactosamine residue." Office Action, page 8, lines 7-10.

Applicants respectfully traverse the rejection. However, solely to expedite prosecution and not in acquiescence to the rejection, Applicants have removed portions of claim 63 (parts (a), (c) and (e), as previously presented in the Preliminary Amendment filed on November 7, 2003) and claims 64, 67, 69 and 70 which are alleged by the Examiner to lack written description. Accordingly, it is believed that the written description rejection under 35 U.S.C. §112, first paragraph has been rendered moot.

Hence, it is respectfully requested that this rejection be withdrawn and that the claims be allowed.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 63-70 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Office Action, page 9, paragraph 6. In particular, the Examiner states that

[t]he term "the lectin has an amino acid insertion, deletion, or substitution when compared with the polypeptide sequence of the corresponding native lectin protein" renders the claim indefinite . . . [since] it is unclear which amino acid has been deleted or substituted, where is the insertion in the sequence, and what amino acid sequence is obtained after modification.

Office Action, page 9, paragraph 7.

The Examiner further states that claim 70 is indefinite for the lack of antecedent basis for the limitation "the nucleic acid coding for the lectin protein." Office Action, page 9, paragraph 8.

Applicants respectfully traverse the rejection. However, solely to expedite prosecution and not in acquiescence to the rejection, Applicants have removed those claims or portions of claims which are alleged by the Examiner to be indefinite.

Accordingly, it is believed that the indefiniteness rejection under 35 U.S.C. §112, second paragraph has been rendered moot. Hence, it is respectfully requested that this rejection be withdrawn and that the claims be allowed.

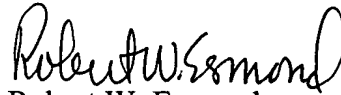
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: April 28, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600